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EXAMINER

KEEHAN, CHRISTOPHER M

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,928

Applicant(s)

KO ET AL.

Examiner

Christopher M. Keehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/11/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32 is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-12, 16-21, 25-31, 33 and 34 is/are rejected.
- 7) ☒ Claim(s) 4-8, 13-15 and 22-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Note: on page 28 of the specification, polydimethylsiloxane is misspelled at numerous occurrences.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 recites the limitation "the backing" in claim 10. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 9, 10, 16, 17, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (EP 0581539A2). Lin et al. disclose an adhesive prepared from the components comprising the instantly claimed components (a) (page 4, lines 33-37), (b) (page 4, lines 27-31), (c) (page 4, lines 18-26), (d) (page 4, lines 38-40), and (e) (page 4, line 43). Lin et al. also disclose

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that the value of z can be from 1 to about 300, and therefore the molecular weight of component (a) can be greater than 20,000. Although Lin et al. do not appear to specifically disclose a number average molecular weight of at least 20,000, as applicant has shown no criticality as to the instantly claimed amount, and Lin et al. show that the molecular weight of the component can be a result-effective variable because the molecular weight has a direct affect on the viscosity of the composition, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have achieved a variety of molecular weights, including a molecular weight with the number average molecular weight as instantly claimed, through routine experimentation and optimization. A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Boesch*, 205 USPQ 215. It has been held that where the general conditions are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 105 USPQ 233, 235.

Regarding claims 9, 10, and 17, Lin et al. disclose an adhesive that is a pressure sensitive adhesive (psa) and an adhesive article comprising a substrate having disposed on at least one major surface the adhesive of claim 1 (page 8, line 47-page 9, line 7).

Regarding claim 16, Lin et al. disclose a layer that is able to be punctured (paragraph bridging pages 8 and 9). The claim has been interpreted as such due

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to the antecedent basis problem as noted above. It is the examiner's position that a puncturable layer is a layer that is capable of being punctured, of which the layers of Lin et al. are certainly capable.

Regarding claim 33, the same reasoning as set forth above for claim 1 also applies to claim 33, as the claimed subject matter is essentially the same, except for the curing limitation. Lin et al. disclose curing the composition (page 8, lines 27-30).

Claims 12, 18-21, 25-30, and 34 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (EP 0581539A2) in view of Finney et al. (5,721,136). Lin et al., as applied to claim 1 above, are as set forth and incorporated herein. Regarding claim 18, Lin et al. disclose the instantly claimed adhesive composition (a) (page 4, lines 33-37), (b) (page 4, lines 18-26), (c) (page 4, lines 38-40), and (d) (page 4, line 43), applied to various substrates (page 8, line 57-col.9, line 7). Lin et al. do not specifically disclose applying the adhesive to a specific article. Finney et al. disclose an analytical receptacle comprising a surface comprising polypropylene (col.7, lines 45-47), and a cover tape adhered to the surface, wherein the cover tape comprises a backing of various substrates, such as those disclosed by Lin et al., and an adhesive disposed on at least a major surface thereof, wherein the adhesive is a silicone curable adhesive (col.4, lines 45-col.5, lines 45). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the article as taught by Finney et al. with the silicone curable psa as

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taught by Lin et because Finney et al. teach that an analytical receptacle with a silicone adhesive thereon produces a reliable seal with a wide variety of substrates, such as those as disclosed by Lin et al., resulting in a higher quality product.

Regarding claim 12, Finney et al. disclose a release liner (col.5, lines 44-46).

Regarding claims 19 and 20, Finney et al. disclose one or more reservoirs as claimed, and a substantially continuous tape (Figure 3).

Regarding claim 21, Finney et al. disclose a psa (col.4, line 52-col.5, line 25). It is the examiner's position that as Finney et al. disclose in this section that surface tackiness and peel strength are important factors, especially limiting the tackiness and peel strength to limit splashing problems upon removing the film, the film acts as a pressure sensitive adhesive.

Regarding claims 25-27, Finney et al. disclose a reservoir including a liquid as instantly claimed, and a microtiter plate (col.7, lines 38-60).

Regarding claims 28-30, Finney et al. disclose the instantly claimed limitations (Figure 3).

Regarding claim 34, Finney et al. disclose the instantly claimed limitations (col.7, lines 38-60).

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finney et al. (5,721,136) in view of Lin et al. (EP 0581539A2). Lin et al., as applied to claim 1 above, are as set forth and incorporated herein. Finney et al.

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disclose an analytical receptacle comprising a surface comprising polypropylene (col.7, lines 45-47), and a cover tape adhered to the surface, wherein the cover tape comprises a backing of various substrates, such as those disclosed by Lin et al., and an adhesive disposed on at least a major surface thereof, wherein the adhesive is a silicone curable adhesive (col.4, lines 45-col.5, lines 45). Finney et al. do not specifically teach the instantly claimed adhesive composition. Lin et al. disclose the instantly claimed adhesive composition (a) (page 4, lines 33-37), (b) (page 4, lines 18-26), (c) (page 4, lines 38-40), and (d) (page 4, line 43), applied to various substrates (page 8, line 57-col.9, line 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the silicone curable psa as taught by Lin et al. to the analytical receptacle of Finney et al. because Lin et al. teach that the silicone adhesive can be applied to a variety of substrates, producing a readily adherable composition with high tack and adhesive strength, resulting in a higher quality product.

Claims 1-3, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tangney (5,082,706) and applicant's admitted prior art. Regarding claims 1-3, Applicant discloses that component (a) (applicant's specification, page 15, lines 19-25), component (b) (paragraph bridging pages 15 and 16 of applicant's specification), component (c) (applicant's specification, page 16, lines 12-16), component (d) (paragraph bridging pages 16 and 17 of applicant's specification), and component (e) (applicant's specification, page 17,

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lines 3-10), are commercially available and/or used in Tangney. The components as discussed above are used in adhesives. It has been held that it is unpatentable to combine separate compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a final composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. *In re Kerkhoven*, 205 USPQ 1069.

Regarding claims 10 and 11, it is the examiner's position that the adhesive as set forth above in this rejection would have to be applied to a substrate or it would serve no purpose.

Allowable Subject Matter

Claim 32 is allowed. A reasonable search of the prior art of record failed to reveal the limitations as set forth in this claim, specifically an adhesive article and adhesive disposed as claimed with the instantly claimed characteristics. Tangney (5,082,706) discloses the instantly claimed components (e), (f), (g), and (h), but do not teach or disclose the release liner and backing layer, with the characteristics as claimed. Tangney et al. also do not teach or disclose an analytical receptacle.

Claims 4-8, 13-15, and 22-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Regarding claims 4-8, the prior art of record does not teach or disclose the

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instantly claimed release liner and backing layer, with the characteristics as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Dawson can be reached on 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Christopher Keehan



June 6, 2003

Robert Dawson
Supervisory Patent Examiner
Technology Center 1700